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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,502	12/22/2005	Domenico Boccuto	236015	4644
23548 7590 07/09/2008 LEYDIG VOIT & MAYER, LTD 700 THIRTEENTH ST. NW SUITE 300 WASHINGTON, DC 20005-3960				
EXAMINER KELLER, MICHAEL J				
ART UNIT 3634		PAPER NUMBER		
NOTIFICATION DATE 07/09/2008		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

### Office Action Summary

**Application No.**

10/537,502

**Applicant(s)**

BOCCUTO, DOMENICO

**Examiner**

Michael J. Keller

**Art Unit**

3634

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 June 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-85/86)
- Paper No(s)/Mail Date 06/03/2005
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 16A and 16B, recited on page 3 of the specification. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 1-17, 22 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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5. The meaning of the term "extent" in claim 1 is not clear to the examiner. It is assumed to refer to the distance which the edge of the panel extends in a direction towards the window opening.
6. The terms "relatively small" and "relatively large" in claim 1 are relative terms which render the claim indefinite. The term "extent" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.
7. The word "extend" in line 3 of claim 1 appears to be a misspelling of the word "extent".
8. The wording of claim 13 is unclear. A suggested rewording would be to replace the word "and" in line 2 with the phrase "also secures the strip to".
9. Regarding claim 22, it is unclear what components are being referred to by the term "them". It is assumed that this term refers to the strips.
10. The term "sharp" in claim 26 is a relative term which renders the claim indefinite. The term "corner" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

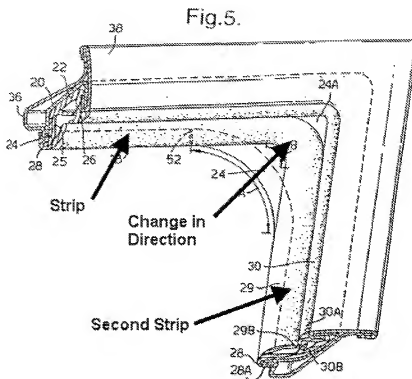
***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. **Claims 1-16 and 18-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Maass (WO 2001/015926).** Maass discloses **[claims 1 & 2]** a sealing strip (18, Fig. 2) made of flexible material mounted to a rigid panel (36) having an edge with a first region (Fig. 3) and a second region (Fig. 4); the strip comprising a length and an edge portion (28, Fig. 3) juxtaposed with the edge of the panel along the first region, a hollow chamber (between 24 and 25, Fig. 3) within the flexible material, a cut line (27, Fig. 3) extending into the chamber, and a separate edge formation (48, Fig. 4) juxtaposed with the edge of the panel along the second region; **[claim 4]** wherein two parts (24,25) are secured to each other (by base 22) leaving between them the hollow chamber; **[claim 5]** wherein the extent of the second region changes with respect to the length of the strip, and the separate edge portion correspondingly changes in size (see Fig. 2 & 4); **[claim 6]** the strip further comprising a channel (between 25 and 26, Fig. 3); **[claim 7]** wherein the separate edge formation is secured to the strip along said cut line (see Fig. 4); **[claim 10]** wherein the hollow chamber extends along the whole length of the strip; **[claim 11]** wherein the strip is secured to a second strip; **[claim 14]** the strip further comprising a channel (between 25 and 26, Fig. 3), said panel forming a part of a window frame and the second region being a region adjacent a change in direction of the window frame (see Fig. 5); **[claim 15]** the strip in combination with a second strip which also defines a channel, the strips being secured together at the change in direction of the window frame; **[claim 16]** wherein the separate edge formation is also secured to the second strip.



Regarding claims 18, 19, 21, 22, 25 and 26, Maas discloses a sealing strip as set forth above wherein the edge formations each comprise a cosmetic lip (28A, Fig. 3 & 4); and wherein the change in direction of the window opening is a sharp corner of the window frame.

Regarding claims 3, 8, 9, 12, 13, 20, 23 and 24, Examiner notes that the method of forming an apparatus does not determine the patentability of the apparatus itself. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-

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process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). In the instant case, the manufacturing methods recited in the above claims do not impart any new structural limitations on the claimed apparatus.

### ***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**14. Claims 17 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maas (WO 2001/015926).** Maas discloses a sealing strip as set forth above formed from a plastic or rubber material, but does not disclose the edge formations being formed from TPE. Examiner takes Official Notice that the use of TPE as a material for sealing strips was known in the art at the time of the invention. It would have been obvious to one of ordinary skill in the art at the time of the invention to form the sealing strip of Maas from TPE, in order to provide the sealing strip with sufficient flexibility and durability.

### ***15. Conclusion***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patents to Vaughan, Backes et al., Dover, Baumann, Aritake et al., Maas and Nozaki disclose seals for corner portions of window frames.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Keller whose telephone number is 571-270-5219. The examiner can normally be reached on Monday - Friday 9:00am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Katherine Mitchell can be reached on 571-272-7069. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/KATHERINE W MITCHELL/  
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/M. J. K./  
Examiner, Art Unit 3634